

REMARKS

In response to the Office Action dated 14 October 2004, Applicants request reconsideration and withdrawal of the rejections set forth in the Office Action in view of the above amendments and the following remarks. Applicants amended claim 1 to put the application in better form for allowance and to add limitations inadvertently removed in the reply dated 08 July 2004. Additionally, Applicants inadvertently omitted claims 5 and 17 in the earlier response but have placed the originally filed claims back in the Listing of Claims. Claim 21 has been cancelled.

Claim Rejections – 35 U.S.C. §103

Claims 1, 3, 12 and 22 were rejected under 35 U.S.C. §103 (a) as being “unpatentable over Yanagi (U.S. Patent No. 6,118,528) in view of Kirschen. (U.S. Patent No. 4,035,082.)” To properly maintain a rejection under 35 U.S.C. §103, the prior art must have suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process, with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in the applicant's disclosure. See *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Moreover, “[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention...” M.P.E.P. §2141.

Applicants have amended claim 1 to include “an illuminating device characterized by producing an image of the contact lens with high resolution.” Yanagi is unacceptable as a primary reference because Yanagi does not include this limitation, which is required by claim 1 and all of its dependencies. Kirschen does not correct the deficiencies of Yanagi. Although Kirschen does disclose a monochromatic light source, it does not disclose an illuminating device characterized by producing an image of the contact lens with high resolution. Rather, Kirschen is directed to “a device to test for the presence of chemically hardened glass.” ‘082 Patent, Abstract. The monochromatic light used in Kirschen is refractively bent to enable detection of chemically hardened glass, it does not provide high resolution of a lens to be checked. There is no suggestion to combine the inspection system described in Yanagi with the monochromatic light source in Kirschen to increase the resolution of the lens. Hence, there cannot be a reasonable expectation of success. Accordingly, the named references cannot render the claims, as presently amended, obvious.

Applicants respectfully submit that with the above amendment to claim 1, the 103(a) rejection has been overcome and claims 1-20 and 22 are in condition for allowance. Applicants respectfully request reconsideration.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Rob Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K. Borrelli', written over a horizontal line.

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Date: 12 January 2005

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